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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,000	11/09/2000	Mark A. Hollar	200	6001

31665 7590 09/09/2003

PATENT DEPARTMENT  
MACROVISION CORPORATION  
2830 DE LA CRUZ BLVD.  
SANTA CLARA, CA 95050

EXAMINER
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ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/711,000

Applicant(s)  
Mark A. Hollar

Examiner  
Pierre E. Elisca

Art Unit  
3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/09/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**Examiner Pierre Eddy Elisca**  
**United States Department of Commerce**  
**Patent and Trademark Office**  
**Washington, D.C. 20231**

**DETAILED ACTION**

1. This Office action is in response to Application No. 09/711,000, filed on 11/09/2000.
2. Claims 1-73 are pending.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-73 are rejected under 35 U.S.C. 102 (e) as being anticipated by Wonfor et al. (U.S. pat. No. 6,381,747).

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As per claims 1, 15, 17-21, 30-35, 38-42, 46, 48-51, 57, 59-63, and 69-73 Wonfor discloses a method/system of providing copy protection of video analog and digital signals and the like, comprising:

ascertaining terms for providing a protected material to a prospective recipient according at least in part to information of unauthorized copying of other protected material previously provided to said prospective recipient (see., abstract, col 4, lines 21-67, specifically wherein it is stated that the right holders authorize video service providers to apply copy protection to the program material); and providing or withholding a copy of said protected material to said prospective recipient in accordance with said terms (see., abstract, col 5, lines 30-67, col 8, lines 18-45, col 7, lines 53-67, col 8, lines 1-8).

As per claims 2, and 22 Wonfor discloses the claimed method wherein said ascertaining further includes obtaining said information of unauthorized copying from a database (see., abstract, col 5, lines 7-65).

As per claims 3, 4, 5, 23, 24, 25, 45, 56, and 64 Wonfor discloses the claimed method wherein said providing comprises providing a copy of said protected material to said prospective recipient in the form of a file (see., abstract, fig 2, digital video, col 5, lines 30-47).

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As per claims 6-14, 16, 26-29, 36, 37, 42-44, 47, 52-55, 58, and 65-68, Wonfor discloses the claimed method of embedding an identification of said protected material in said copy prior to providing said copy to said prospective recipient (see., col 7, lines 53-67, col 8, lines 1-8, please note that embedding identification is readable as a password or watermark).

5. Claims 1-73 are rejected under 35 U.S.C. 102 (e) as being anticipated by Sims, III (U.S. pat. No. 6,438,235).

As per claim 1, 1, 15, 17-21, 30-35, 38-42, 46, 48-51, 57, 59-63, and 69-73 Sims discloses a method/system for providing copy protection of content stored on a bulk storage media, comprising: ascertaining terms for providing a protected material to a prospective recipient according at least in part to information of unauthorized copying of other protected material previously provided to said prospective recipient (see., abstract, col 2, lines 21-67, specifically wherein it is stated that under the terms of a license agreement); and providing or withholding a copy of said protected material to said prospective recipient in accordance with said terms (see., abstract, col 2, lines 21-67, col 3, lines 7-45, col 7, lines 53-67, col 8, lines 1-8).

As per claims 2, and 22 Sims discloses the claimed method wherein said ascertaining further includes obtaining said information of unauthorized copying from a database (see., abstract, col 2, lines 44-62).

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As per claims 3, 4, 5, 23, 24, 25, 45, 56, and 64 Sims discloses the claimed method wherein said providing comprises providing a copy of said protected material to said prospective recipient in the form of a file (see., abstract, col 3, lines 35-47).

As per claims 6-14, 16, 26-29, 36, 37, 42-44, 47, 52-55, 58, and 65-68, Sims discloses the claimed method of embedding an identification of said protected material in said copy prior to providing said copy to said prospective recipient (see., col 1, lines 64-67, col 2, lines 1-13, col 4, lines 25-64, col 8, lines 1-8, please note that embedding identification is readable as a password or watermark or key).

***Conclusion***

6. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

**Any response to this action should be mailed to:**

Commissioner of patents and Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

**(703) 305-7687**

**Serial Number: 09/711,000**

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Pierre Eddy Elisca

Patent Examiner

**September 03, 2003**